

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 3-4, 11, 13, 53-66 and 105 are canceled, claims 109-123 are added, and claims 15-52, 67-104 and 106-108 were withdrawn by the Examiner. Claims 1-2, 5-10, 12 and 14 remain in this application as amended herein. Accordingly, claims 1-2, 5-10, 12, 14 and 109-123 are submitted for the Examiner's reconsideration.

Claims 5-6, 8, 12 and 14 have been amended solely to provide proper antecedence and to have the claims better conform to the requirements of U.S. practice. None of these amendments is intended to narrow the scope of any of these claims, and no new matter has been added by these amendments.

In the Office Action, the Examiner rejected claims 1-108 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner contends that "[t]aken as a whole the claims recite an undue multiplicity of claims by virtue of the unreasonable number of claims presented would tend to obfuscate, confuse, and becloud the claimed invention." (Official Action at 2.) Applicants respectfully disagree. Rather, a comparison of the language of, e.g., each of the independent method claims 1, 15, 29 and 39, shows that though the scope of each claim at least partially overlaps that of the others, each claim also covers additional subject matter. Therefore, each of the claims defines a unique combination of steps, and the Applicants consider each combination to be an aspect of Applicants' invention. Therefore, each of the claims particularly points out and distinctly claims subject matter, i.e., a combination, that the Applicants regard as their invention. See 37 C.F.R. 1.75(a) and M.P.E.P. § 2173.05(n). Similarly, a comparison of the language of independent apparatus claims 67, 81, 91 and 111

(each of which defines a communication device that includes limitations recited in a means-plus-function format) or a comparison of the language of independent apparatus claims 106, 107, 108 and 123 (each of which defines a communication device that includes limitations recited as structural limitations) also indicates that each of these claims particularly points out and distinctly claims subject matter that the Applicants regard as their invention.

The Examiner also expresses his belief that "in his judgment that twenty-five claims (25) are sufficient to properly define Applicants' invention." (Official action at 2.) However, for the reasons set out above, it is clear that more than twenty-five claims are needed. Also, the Examiner asserts that the new excess claim fees effective December 12, 2004 is evidence of what is considered unreasonable. However, it is submitted that when the U.S. Congress enacted the Consolidated Appropriations Act, no consideration was given to the number of claims necessary to reasonably claim Applicants' invention. Rather, the fee structure was devised to address well-known policy and fiscal issues. Clearly, the excess-claim fees cannot be considered evidence that the number of claims in this case is unreasonable.

The Examiner also withdrew claims 15-108 from consideration and required the selection of no more than 25 claims for examination on the merits. Though the Applicants maintain that the rejection of the claims is improper for the reasons set out above, the Applicants have nevertheless canceled claims 3-4, 11, 13, 53-66 and 105 and added claims 109-123 in place thereof so that the Applicants may provisionally provide the Examiner with twenty-five claims (namely, claims 1-2, 5-10, 12, 14 and 109-123) for examination. It is therefore submitted that the claims are in full compliance with the requirements of 35 U.S.C. § 112, second paragraph.

Turning to the art rejection, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Kawan (U.S. Patent No. 5,796,832) in view of Dulude (U.S. Patent No. 6,310,966). Claims 3-4, 11 and 13 are cancelled. It is submitted that the remaining claims are patentably distinguishable over the cited references.

The Kawan patent describes a financial transaction in which: (i) a user inserts a smart card into a smart card reader of a terminal, (ii) the smart card then encrypts information stored on the smart card that identifies the user's financial institution and account number, (iii) the smart card transmits the encrypted information to the terminal which, in turn, transmits the encrypted information to a host computer associated with a financial institution for verification, (iv) the terminal then receives authorization from the host computer, (v) the user next enters a request for an account balance or to add value to the smart card, and thereafter (vii) the terminal transmits the request to the host terminal. (See Figs. 1 and 4; and col. 5, lines 1-30). Thus, Kawan discloses a transaction during which the user is required to carry out an *additional step* after authorization is obtained. Namely, during Kawan's disclosed financial transaction, the user first requests authorization (by inserting the smart card), and then, after *authorization is obtained*, the user manually enters the information needed to complete the transaction. The patent does not disclose or suggest *automatically transmitting* the information needed to complete the transaction. As a result, Kawan does not provide the user with the convenience of having the transaction *automatically go forward* when authorization is obtained, an advantage provided by the method recited in claim 1.

Moreover, though Kawan describes that a fingerprint or other biometric parameter may be used for identification, the

patent merely indicates that the biometric parameter may be provided together with insertion of the smart card to obtain entry into a building. The patent neither discloses nor suggests automatically transmitting the information needed to complete a transaction when the biometric parameter generated by the user matches a stored biometric parameter.

The *Dulude* patent describes an electronic transaction wherein: (i) a user inputs transaction first data, which includes a user ID and may include product selection data or electronic fund transfer data, and inputs transaction biometric data into a transaction transmission section, (ii) the transaction transmission section then sends both the transaction first data and the transaction biometric data to a receiving section which compares the transaction biometric data to previously supplied registration biometric data, and (iii) if the transaction biometric data is validated, the receiving section sends a validation signal to a transaction processing system. (See Figs. 4 and 5; col. 5, lines 50-67; col. 7, lines 26-44; and col. 8, lines 1-7). *Dulude* thus describes that the transaction transmission section transmits the transaction first data, which includes user data and transaction-related data, before the transaction biometric data is validated. The patent does not disclose or suggest automatically transmitting the information needed to complete a transaction when the transaction biometric data substantially matches the registration biometric data. Also, because the transaction first data is transmitted before the transaction biometric data is validated, the electronic transaction described by *Dulude* does not afford the security provided by the method defined in claim 1.

Neither *Kawan* nor *Dulude* suggests:

automatically transmitting, from said communication device over said network to said provider, both said

information needed to complete said transaction and a verification signal if said generated unique identification trait substantially matches said stored unique identification trait

as called for in claim 1.

It follows that neither *Kawan* nor *Dulude*, whether taken alone or in combination, discloses or suggests the method set out in claim 1, and claim 1 is therefore patentably distinct and unobvious over the references.

Claims 2, 5-10, 12 and 14 depend from claim 1, and each further defines and limits the invention set out in the independent claim. It follows that each of claims 2, 5-10, 12 and 14 is patentably distinguishable over the cited references for at least the same reasons.

Further regarding claim 5, the Examiner erroneously contends that *Kawan* shows point of sale data terminal access and then incorrectly concludes that such access is the functional equivalent of the limitations recited in claim 5. However, *Kawan* merely shows terminals that are used to read the amount of funds stored on a smart card so that the user can then add to the monetary amount stored on the card using the terminal. (See Figs. 2A-2C, 3A-3B and 4; col. 3, lines 9-13 and 57-67; col. 4, lines 57-67; col. 5, lines 10-30 and 38-48; and col. 6, lines 13-35). The patent is not concerned with point of sales terminals. Moreover, *Kawan* does not disclose or suggest that any of the terminals shown in 2A-2C, 3A-3B and 4 provides a form that is to be completed. Similarly, the *Dulude* patent does not remedy these deficiencies. Therefore, neither reference, whether taken alone or in combination, discloses or suggests:

said information needed to complete said transaction comprises information provided by said person to complete an order form of said provider

as recited in claim 5.

Accordingly, the withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

New claims 109-110 depend from claim 1 and are therefore distinguishable over *Kawan* and *Dulude* for at least the reasons described above. Support for claims 109-110 is found, e.g., in Figs 3-4 and in paragraphs [0025] and [0030] of the specification.

New independent claim 111 is directed to a communication device and includes means-plus-function elements that perform operations recited in claim 1, and new independent claim 123 is directed to a communication device and defines specific structure that carries out operations recited in claim 1. Therefore, each of claims 111 and 123 is distinguishable over *Kawan* and *Dulude* for at least the same reasons. Further, claims 111 and 123 are similarly supported by the disclosure of the present application.

New claims 112-122 depend from claim 111 and, for at least the same reasons, are distinguishable over the cited references. Moreover, claim 114 includes limitations similar to those called for in claim 5 and is further distinguishable over the cited art at least for the same reasons. Claims 112-122 also define limitations similar to those recited in claims 2, 5-10, 12, 14 and 109-110, and, therefore, claims 112-122 are similarly supported.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.


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If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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